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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,432	02/17/2000	John R. Stevens	032795-001	6452

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EXAMINER
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NGUYEN, DINH X

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/506,432

Applicant(s)

STEVENS ET AL.

Examiner

Dinh X. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barr et al., USPN 5,182,705 or Johnson et al., USPN 4,987,538 or DiRienzo, USPN 6,343,310 or Tarter et al., USPN 5,704,044.

As per claim 1, the claim calls for a system comprising:

Software accessed at a provider computer, the software adapted to prompt the provider to input data concerning a worker's compensation claim, the software adapted to send an electronic claim number request containing at least some of the data across the Internet to a worker's compensation claim verification system; and

A worker's compensation claims verification system adapted to receive the at least some of the data and to determine therefrom any matching worker's compensation claim number, if there is a matching workers' compensation claim number, the workers' compensation claims verification number to the provider computer, if there is no matching workers' compensation claim number, the workers' compensation claims verification system is adapted to produce an indication of the lack of the workers' compensation claim number.

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Barr et al., Johnson et al., DiRienzo and Tarter et al. all disclose systems and methods dealing with health care accounts including workers compensation. See for example, Barr et al. at abstract, column 1 lines 44-60, column 3 lines 35-60, column 6 lines 35-42; Johnson et al. at abstract, figure 2, column 2 lines 45-50, column 3 lines 19-30, column 4 lines 16-25, DiRienzo at abstract, figures 5A-5B, column 2 lines 1-65, column 5 lines 35-40, column 10 lines 5-10 and 15-20, column 17 lines 30-35, column 20 lines 10-15 and 33-38, column 22 lines 10-17; Tarter et al. at abstract, figures 30, 31, 34, column 4 lines 40-60, column 5 lines 12-17 and 49-52, column 16 lines 40-50, column 18 line 12 to column 19 line 9, column 31 lines 19-35, column 36 lines 25-57.

Applicant's "inventive concept" pertains to identification, verification or creation of an identification claim number for tracking purposes. As seen from the above recitations, the prior art cited all have objectives of creating a better tracking system, may it use attachments, etc. The prior art is not explicit as to the creation of a new identification claim number. Examiner takes the position that all other features as claimed by Applicant are either disclosed in the prior art references as cited above or takes official notice that these other features are well known in the art.

As to the task of checking up on a claim identification number and creating a new one, the following rationale is taken in rejection of this feature. First, depending on the type of claims, most providers and payers use a tracking number or identification number, may it be a social security number or a different number. The problem of tracking of claims and faster processing of such are all addressed in the prior art. Applicant's claim language does not require a claim identification to be something

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different from a social security number. Regardless, it is a design choice as to what each party considers as a claim identification number. Nevertheless, the prior art as cited above all have systems and methods for collection of information for claim processing. Many use a particular form and requirement of information for faster processing. If certain requirements and filling out of forms are not met, some systems and methods reject the claims. Thus, it depends on the system as to what is important to reject a claim and to either request additional information or reject a claim. This may include whether an identification claim number is provided or not by those submitting the claim. Thus, if a particular system finds out that an important piece of information, such as a claim identification number, most likely to be considered an important piece of information in claims processing, is not provided, it would have been obvious to one of ordinary skill in the art to have the motivation of notifying that the particular information is not met, such as a claim identification number, and requesting the information or rejecting the claim, in order to faster process the claim. Note additionally, that if a system does not accept a form in an electronic data communication system, this is automatically deemed as an indication that there is a lack of information or improper information, as required in the claim language. This is routinely performed in data processing and relational databases. The renaming of attachments for addition of new data or for temporary storage or back up of data is also well known and obvious to one of ordinary skill in the art.

With respect to claims 2-54, the remainder independent claims and the dependent claims, see above citations. These claims, the independent claims are

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drawn toward the billing attachments, as disclosed in the prior art, and the renaming of attachments, as applied in the above rejection.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior cited in Applicant's IDS are relevant for the following reasons, and are applicable in art rejections. Doyle, Jr. et al., USPN 4,916,611 disclose general health claims not specific to worker's compensation and claim numbers, but does disclose tracking and sending out billings. Doyle, Jr. et al., USPN 5,070,452 has similar disclosure as the '611 patent. Johnson et al., USPN 4,987,538 although does not disclose explicitly claim number, they do disclose claim identification using names, date of injury, etc. Berman et al., USPN 5,995,939 disclose general health care database with internet capability for universal interfaces.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinh X. Nguyen whose telephone number is (703) 305-3522. The examiner can normally be reached on Monday to Friday and alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

DXN  
August 21, 2002

  
DINH X. NGUYEN  
PRIMARY EXAMINER